

REMARKS

Claims 1-8 and 11-20 remain pending. In the Office Action¹, the Examiner rejected claims 1-8 and 11-20 under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. (U.S. Patent No. 6,366,622) ("Brown") in view of Fujioka (U.S. Patent No. 6,907,227) ("Fujioka"), and further in view of Lee et al. (U.S. Patent Publication No. 2002/0090968) ("Lee"). Applicant respectfully traverses the rejection for at least the following reasons.

Rejection of Claims 1-8 and 11-20 under 35 U.S.C. § 103(a):

Applicant traverses the rejection of claims 1-8 and 11-20 under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Fujioka, and further in view of Lee. No *prima facie* case of obviousness has been established for these claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145*. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III), internal*

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966)... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

Here, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

With respect to independent claim 1, claim 1 calls for “[a] master communication device capable of simultaneously communicating with slave communication devices within a first limited number determined in advance, comprising: ... a connected number judgment unit configured to judge whether or not the number of said slave communication devices connected currently reaches a second limited number less than said first limited number; [and] a release selection unit configured to select at least one

of said slave communication devices to be released, when determined to have reached said second limited number" (emphasis added). Brown fails to teach or suggest at least this element of claim 1.

The Examiner admitted that Brown does not disclose the above element of claim 1 (see Office Action, p 3-4). The Examiner then alleged that Fujioka discloses "a connected number judgment unit configured to judge whether or not the number of said slave communication devices connected currently reaches a second limited number; [and] a release selection unit configured to select at least one of said slave communication devices to be released, when determined to have reached said second limited number" (Office Action, p. 3), and that Lee discloses "the second limited number is less than said first limited number" (Office Action, p. 4). However, these allegations are not correct.

Fujioka fails to cure the deficiencies of Brown. Fujioka discloses that "[s]lave terminals and a master terminal are wirelessly connected according to the Bluetooth protocol. When a number of the slave terminals exceeds a predetermined number of the slave terminals for the wireless connection, the wireless connections are controlled by a predetermined set of rules. Active slave terminals are switched into inactive slave terminals according to the predetermined rules so as to efficiently use the resources in the system" (Abstract, emphasis added). However, neither Brown, nor Fujioka, nor any combination thereof, teaches "[a] master communication device capable of simultaneously communicating with slave communication devices within a first limited number determined in advance, comprising: ... a connected number judgment unit configured to judge whether or not the number of said slave communication devices

connected currently reaches a second limited number less than said first limited number; [and] a release selection unit configured to select at least one of said slave communication devices to be released, when determined to have reached said second limited number,” as recited in claim 1 (emphasis added).

Lee fails to cure the deficiencies of Brown and Fujioka. The Examiner alleged that “Lee teaches in paragraph [0054] “[t]he memory 32 stores priorities of the slave devices that are currently linked to the Piconet. Further, the memory 32 stores a maximum number of slave devices of the high priority and medium priority, respectively (hereinafter called ‘high priority maximum number’ and ‘medium priority maximum number’, respectively)” in order to “prevent an excessive number of slave devices from having high and medium priorities in the Piconet”” (Office Action, p. 4). However, whether this allegation is correct or not, neither Brown, nor Fujioka, nor Lee, nor any combination thereof, teaches “[a] master communication device capable of simultaneously communicating with slave communication devices within a first limited number determined in advance, comprising: ... a connected number judgment unit configured to judge whether or not the number of said slave communication devices connected currently reaches a second limited number less than said first limited number; [and] a release selection unit configured to select at least one of said slave communication devices to be released, when determined to have reached said second limited number,” as recited in claim 1 (emphasis added).

In view of the shortcomings of the prior art and the errors in analysis of the prior art set forth in the Office Action, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the

claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of independent claim 1 and, hence, dependent claims 2-8 is therefore improper and should be withdrawn.

Independent claims 11, 13, and 17, although different in scope from claim 1 and from each other, recite elements similar to claim 1 and are thus allowable for at least the reasons discussed above with respect to claim 1. Therefore, the 35 U.S.C. § 103(a) rejection of claims 11, 13, and 17 and, hence, dependent claims 12, 14-16, and 18-20 is also improper and should be withdrawn.

Conclusion:

In view of the foregoing, Applicant requests reconsideration of the application and withdrawal of the rejection. Pending claims 1-8 and 11-20 are in condition for allowance. Accordingly, Applicant requests a favorable action.

If there are any remaining issues or misunderstandings, Applicant requests the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 20, 2010

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